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Alan W. Young
YOUNG LAW FIRM
4370 Alpine Road, Suite 106
Portola Valley, CA 94028

In re Application of :
HELLE, Jacky, et al. :
U.S. Application No.: 09/582,006 :
PCT No.: PCT/FR98/02776 : COMMUNICATION
International Filing Date: 18 December 1998 :
Priority Date: 19 December 1997 :
Attorney's Docket No.: MUNR5702 :
For: DEVICE AND METHOD FOR MOUNTING A :
SADDLE HUB ON A PIPE AND CORRESPONDING :
TYPE :

This application is before the PCT Legal Office for issues arising under 35 U.S.C. 371.

BACKGROUND

On 18 December 1998, applicants filed international application PCT/FR98/02776 which claimed a priority date of 19 December 1997 and which designated the United States. On 01 July 1999, a copy of the international application was communicated to the United States Patent And Trademark Office ("USPTO") by the International Bureau ("IB").

On 29 June 1999, a Demand was filed with the International Preliminary Examining Authority electing the United States. The election was made prior to the expiration of nineteen months from the priority date. As a result, the deadline for payment of the basic national fee was extended to expire thirty months from the priority date, i.e., 19 June 2000.

On 20 June 2000, applicants filed a transmittal letter for entry into the national stage in the United States accompanied by, among other materials, a purported translation of the international application into English and payment of the basic national fee. The transmittal letter contains a certification that the submission was deposited as Express Mail Label No. EL426709835US on 19 June 2000; however, the receipt date stamped on these materials by the USPTO is 20 June 2000, and USPTO records indicate that this Express Mail envelope was deposited with the USPS on 20 June 2000 at 4:00 pm.

On 14 July 2000, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497 and a surcharge for providing the oath or declaration later than 30 months from the priority date were required. The Notification

also informed applicants that the failure to submit these materials within one month of the date of the Notification would result in abandonment of the application.

On 30 October 2000, applicants filed a response to the Notification Of Missing Requirements which included the small entity surcharge for filing the declaration after the thirty month date, a petition for a four month extension of time to respond (with small entity fee), a declaration executed by one of the two co-inventors, and an affidavit executed by the signing inventor stating that the nonsigning inventor has refused to execute the application.

DISCUSSION

As noted above, the thirty-month deadline for filing the basic national fee expired on 19 June 2000. However, USPTO records indicate that the Express Mail envelope in which the basic national fee and other materials were submitted was not deposited with the USPS until 20 June 2000. Applicants therefore failed to timely file the basic national fee. Accordingly, pursuant to 37 CFR 1.495(h), this application became abandoned as to the United States at midnight on 19 June 2000. The Notification Of Missing Requirements mailed on 14 July 2000 is therefore appropriately vacated. A Notification Of Abandonment (Form PCT/DO/EO/909) will be issued indicating the abandonment of this application.

It is noted that the transmittal letter filed by applicants indicates a 19 June 2000 deposit date for the Express Mail envelope containing this submission. If applicants can verify this 19 June 2000 deposit date through a grantable petition under 37 CFR 1.10(c), the holding of abandonment will be withdrawn. Otherwise, applicants will need to file a grantable petition under 37 CFR 1.137(a) or (b) to revive this application.

Should applicants successfully petition for withdrawal of the abandonment or, in the alternative, successfully petition to revive the application, then the issue regarding the failure of co-inventor Alain Calca to execute the filed declaration would need to be addressed. Applicants should note that the materials submitted on 30 October 2000 do not constitute a grantable petition under 37 CFR 1.47(a). A petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17(i), (2) a statement of the last known address of the inventor; (3) an oath or declaration executed by the other inventors on their own behalf and on behalf of the non-signing inventor; and (4) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort. Applicants' submission only satisfies item (3). Applicants should review section 409.03(d) of the Manual of Patent Examining Procedure ("MPEP") with respect to item (4), that is, the factual proof required to demonstrate a refusal to execute the application documents (including the requirement that applicants provide sufficient firsthand evidence that "a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature").

Finally, applicants have not submitted a translation of the international application as filed; rather, the translation filed appears to be a translation of the international application with the annexes to the IPER. Applicants should also note that, because a proper translation into English of the international application as filed was not submitted before the thirty month deadline, they are also required to submit the processing fee for filing such translation after the thirty month deadline.

CONCLUSION

This application is **ABANDONED** as of midnight on 19 June 2000 for failure to pay the basic national fee before the expiration of thirty months from the priority date.

The Notification Of Missing Requirements mailed 14 July 2000 is hereby **VACATED**.

Treatment under 37 CFR 1.47(a) of applicants submission of a declaration executed by only one of the two co-inventors has been held in abeyance based on the holding of abandonment, but applicants should note the insufficiencies in such submission outlined above.

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations for further processing in accord with this decision, including the issuance of a Notification Of Abandonment (Form PCT/DO/EO/909).



Leonard Smith
PCT Legal Examiner
PCT Legal Office

RMR/LS:rmr



Richard M. Ross
PCT Petitions Attorney
PCT Legal Office
Telephone: (703) 308-6155
Facsimile: (703) 308-6459